REMARKS

Claims 1-7, 9-13, and 16-25 were pending in this application. Claim 25 has been amended. New claim 26 has been added. No new subject matter is believed to have been added by these amendments. Therefore, claims 1-7, 9-13, and 16-26 remain in this application.

Claim 25 has been amended to require the advertising banner to be a graphic. Claim 26 has been added to claim that the transmission of the banner to be displayed in the email interface of a first computer is in response to a server receiving one or more email client objects from a second computer.

35 U.S.C. § 102 Rejections

Claim 25 stands rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,199,106 to Shaw et al. Specifically, the Examiner asserts that Shaw teaches an email message interface having a "from" field, a "to" field, a "subject" field, and an email message text window. Fig. 12 of the Shaw patent does indeed show an email message interface having these elements. The specification of the Shaw patent describes a "message field" (1205) as "a portion of the email template *(i.e., email message interface)* where the user can write a message, i.e., fill in the message body." (See column 21, lines 53-55). As shown in Fig. 12, the banner advertisement (800) is clearly outside of the "message field" (1205), and accordingly, is not displayed therein, as is required by claim 25.

Nonetheless, claim 25 has been amended to require the advertising banner displayed within the message field to be a graphic, as opposed to text, such as a textual hyperlink. In view of the above amendments and the foregoing remarks, the Applicant respectfully requests reconsideration of this rejection of claim 25.

Furthermore, claim 26 has been amended to require that transmission of the banner to be displayed in the message field of a first computer is in response to a server receiving one or more email client objects from a second computer. Claim 26 depends from and adds further limitations to amended independent claim 25 and is believed to be patentable for the reasons discussed hereinabove in connection with amended independent claim 25.

35 U.S.C. § 103 Rejections

Claims 1, 9-13, 16-24 stand rejected under 35 U.S.C. § 103(a) for obviousness based upon the Shaw patent in view of United States Patent No. 6,055,573 to Gardenswartz et al.

With respect to independent claims 1 and 13, the Examiner asserts that the Shaw patent teaches all the claimed limitations but for the second computer. The Applicant respectfully disagrees with this assertion. The Shaw patent does not disclose a first computer configured to transmit an a) email message; b) identification data; and c) email client objects to a second computer, wherein the second computer is configured to transmit the identification data and email client objects to a server, wherein the server in response to receiving the identification data and email client object selects an advertisement to be transmitted to the second computer to be displayed thereon. Basically, the present invention involves advertising content to be dynamically displayed at a recipient's computer based upon email client objects sent from a transmitter's computer to the recipient's computer. When the email message is read at the recipient's computer, the email client objects are transmitted to a server, wherein the server uses the email client objects to select an appropriate advertisement which is then transmitted to the recipient's computer to be displayed contemporaneously with the actual email text of the email message.

In contrast, the Shaw patent involves "targeted advertising to be delivered to a first computer in response to receiving an identifier from the first computer" (see abstract). Thus, in Shaw, the advertisements are sent to the recipient's computer in response to the first computer sending identifying information to the server. The present invention, as claimed, requires a transmitter's computer to send to a recipient's computer via an email, identifying information and email client objects embedded therein, such that were it not for the email transmitted by the transmitter's computer, the recipient's computer would not receive the targeted advertising content from the server. Accordingly, the Shaw patent, either alone or in combination with the Gardenswartz patent or any other prior art of record fails to disclose, teach, or suggest the interaction between a first computer, a second computer, and a server in causing the second computer to receive an advertisement from the server whereby the advertisement is displayed in the message field of an email message received from the first computer.

For the foregoing reasons, the Applicant believes that the subject matter of independent claims 1 and 13 are not rendered obvious by the Shaw patent in view of the Gardenswartz patent. Reconsideration of the rejections of claims 1 and 13 is respectfully requested. Claims 2-7, 9-12, and 23-24 depend from and add further limitations to independent claim 1 and are believed to be patentable for the reasons discussed hereinabove in connection with independent claim 1. Claims 16-22 depend from and add further limitations to independent claim 13 and are believed to be patentable for the reasons discussed hereinabove in connection with independent claim 13. Accordingly, dependent claims 2-7, 9-12, 16-22, and 23-24 are also deemed allowable.

CONCLUSION

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-7, 9-13, and 16-26 are requested.

Respectfully submitted,

THE WEBB LAW FIRM

By _____

John W. McIlvaine
Registration No. 34,219
Attorney for Applicant
700 Koppers Building
436 Seventh Avenue
Pittsburgh, Pennsylvania 15219-1845
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com